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10/743,491	12/23/2003	Toshimitsu Ichiyanagi	016907-1592	7810
22428	7590	06/27/2006	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			WYATT, KEVIN S	
			ART UNIT	PAPER NUMBER
			2878	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/743,491

Applicant(s)

ICHIYANAGI, TOSHIMITSU

Examiner

Kevin Wyatt

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7,9,13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7,9,13 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Office Action is in response to the Request for Continued Examination and remarks filed on 04/21/2006. Currently, claims 7, 9, 13, and 15 are pending.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 7, 9, and 13, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Shinoda (Publication No. U.S. 2003/0133153 A1).

Regarding claim 7, Shinoda shows in Fig. 1, a copying machine comprising: an optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) which optically scans a surface of an original (25, i.e., recording medium), and converts an image on the surface of the original into image data (35 i.e., recorded information of a file, paragraph 0020, line 11); a radio reader (combination of wireless network and chip id reader terminal (71)) which reads data from an IC chip embedded in the original and having a radio communication function (paragraph 0020, lines 1-11); an image forming unit (60, i.e., printer) which prints an image on a surface of an image forming medium (paragraph 0019, lines 4-7); a radio writer (combination of wireless

network and id managing center (50)) which writes data on an IC chip (40) embedded in the image forming medium (20, i.e., recording medium) and having a radio communication function (paragraph 0017, lines 1-3): an operational mode setting unit (14, i.e., program database) which sets the data to be written on the IC chip (40) embedded in the image forming medium by the radio writer ( combination of wireless network and id managing center (50)), and the image data (30,i.e., document) to be printed on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (paragraph 0015, lines 19-25): a first control unit (combination of program database(14), id managing database (12), managing server (10), wireless network, and id managing center (50)) which selects the data to be written on the IC chip embedded in the image forming medium (20, i.e., recording medium) by the radio writer based on an operational mode set by the operational mode setting unit (modes of operation (scanning, printing or chip id issuing or authenticating) are executed by programs stored in program database (14) and the identification is recorded on the chip (40) by id managing center (50), paragraph 0017, lines 1-11 ); and a second control unit (combination of original data managing database (13), program database (14), managing server (10), and wireless network) which selects the data to be printed on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer) based on the operational mode set by the operational mode setting unit (managing server (10) facilitates the execution of modes of operation, paragraph 0013, lines 1-12); and a control panel to which the operational mode is input by a user, wherein the second control unit (combination of original data managing database (13),

program database(14), managing server (10), and wireless network) selects one of the image data on the surface of the original (25, i.e., recording medium) which has been optically scanned by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45, i.e., contactless IC chip) embedded in the original by the radio reader (combination of wireless network and chip id reader terminal (71) ) , as the image data (35 i.e., recorded information of a file, paragraph 0020, line 11) to be printed on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer), based on the operational mode set by the operational mode setting unit (paragraph 0013, lines 1-12), the operational mode setting unit (14, i.e., program database) sets one of the image data of the original (25, i.e., recording medium) acquired by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45, i.e., contactless IC chip) of the original by the radio reader (combination of wireless network and chip id reader terminal (71)) as the data to be printed as the image on the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer), based on the operational mode input to the control panel (paragraph 0012, lines 7-10, and (paragraph 0013, lines 1-12)).

Regarding claim 9, Shinoda shows in Fig. 1, a copying machine comprising: an optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) which optically scans a surface of an original (25, i.e., recording medium), and converts an image on the surface of the original into image data (35 i.e., recorded information of a file, paragraph 0020, line 11); a radio reader (combination of wireless

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network and chip id reader terminal (71)) which reads data from an IC chip embedded in the original and having a radio communication function (paragraph 0020, lines 1-11); an image forming unit (60, i.e., printer) which prints an image on a surface of an image forming medium (paragraph 0019, lines 4-7); a radio writer (combination of wireless network and id managing center (50)) which writes data on an IC chip (40) embedded in the image forming medium (20, i.e., recording medium) and having a radio communication function (paragraph 0017, lines 1-3); an operational mode setting unit (14, i.e., program database) which sets the data to be written on the IC chip (40) embedded in the image forming medium by the radio writer ( combination of wireless network and id managing center (50)), and the image data (30,i.e., document) to be printed on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (paragraph 0015, lines 19-25); a first control unit (combination of program database(14), id managing database (12), managing server (10), wireless network, and id managing center (50)) which selects the data to be written on the IC chip embedded in the image forming medium (20, i.e., recording medium) by the radio writer based on an operational mode set by the operational mode setting unit (modes of operation (scanning, printing or chip id issuing or authenticating) are executed by programs stored in program database (14) and the identification is recorded on the chip (40) by id managing center (50), paragraph 0017, lines 1-11 ); a second control unit (combination of original data managing database (13), program database (14), managing server (10), and wireless network) which selects the data to be printed on the surface of the image forming medium (20, i.e., recording medium) by the image forming

unit (60, i.e., printer) based on the operational mode set by the operational mode setting unit (managing server (10) facilitates the execution of modes of operation, paragraph 0013, lines 1-12); and a control panel to which the operational mode is input by a user, wherein the second control unit (combination of original data managing database (13), program database(14), managing server (10), and wireless network) selects one of the image data on the surface of the original (25, i.e., recording medium) which has been optically scanned by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45, i.e., contactless IC chip) embedded in the original by the radio reader (combination of wireless network and chip id reader terminal (71) ) , as the image data (35 i.e., recorded information of a file, paragraph 0020, line 11) to be printed on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer), based on the operational mode set by the operational mode setting unit (paragraph 0013, lines 1-12), and wherein the operational mode setting unit (14, i.e., program database) sets one of the image data of the original (25, i.e., recording medium) acquired by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45, i.e., contactless IC chip) of the original by the radio reader (combination of wireless network and chip id reader terminal (71)) as the data to be printed as the image on the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer), based on the operational mode input to the control panel (paragraph 0012, lines 7-10, and (paragraph 0013, lines 1-12)), wherein the first control unit (combination of program database(14), id managing

database (12), managing server (10), wireless network, and id managing center (50)) selects one of the image data (35 i.e., recorded information of a file) on the surface of the original (25, i.e., recording medium) which has been optionally scanned by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45, i.e., contactless IC chip) embedded in the original by the radio reader as the data to be written on the IC chip (40) embedded in the image forming medium (20, i.e., recording medium) by the radio writers based on the operational mode set by the operational mode setting unit (paragraph 0013, lines 1-12).

Regarding claim 13, Shinoda shows in Fig. 1, a copying machine comprising: a scanner (71, i.e., reader terminal); a printer (60), and a system control unit, wherein the scanner includes: an optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) which optically scans a surface of an original (25, i.e., recording medium), and converts an image on the surface of the original into image data (35, i.e., document); and a radio reader (combination of wireless network and chip id reader terminal (71) ) which reads data from an IC chip (40, i.e., contactless IC chip) embedded in the original and having a radio communication function (RFID, i.e., Radio Frequency Identifier, paragraph 0024 lines 1-5), the printer includes: an image forming unit (60, i.e., printer) which prints an image on a surface of an image forming medium (20, i.e., recording medium); and a radio writer (combination of wireless network and id managing center (50)) which writes data on an IC chip (45, i.e., contactless IC chip) embedded in the image forming medium (20, i.e., recording medium) and having a radio



communication function (RFID, i.e., Radio Frequency Identifier, paragraph 0024 lines 1-5), and the system control unit includes: an operational mode setting unit (14, i.e., program database) which sets the data to be written on the IC chip (45, i.e., contactless IC chip) embedded in the image forming medium (20, i.e., recording medium) by the radio writer (combination of wireless network and id managing center (50)), and the image data (35, i.e., document) to be printed on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer); a first control unit (combination of program database(14), id managing database (12), managing server (10), wireless network, and id managing center (50)) which selects the data to be written on the IC chip embedded in the image forming medium (20, i.e., recording medium) by the radio writer based on an operational mode set by the operational mode setting unit (modes of operation (scanning, printing or chip id issuing or authenticating) are executed by programs stored in program database (14) and the identification is recorded on the chip (40) by id managing center (50), paragraph 0017, lines 1-11 ); and a second control unit (combination of original data managing database (13), program database (14), managing server (10), and wireless network) which selects the data to be printed on the surface of the image forming medium by the image forming unit, based on the operational mode set by the operational mode setting unit; and a second control panel to which the operational mode is input by the user, wherein the second control unit (combination of original data managing database (13), program database(14), managing server (10), and wireless network) selects one of the image data on the surface of the original (25, i.e., recording medium) which has been optically

scanned by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45, i.e., contactless IC chip) embedded in the original by the radio reader (combination of wireless network and chip id reader terminal (71) ) , as the image data (35 i.e., recorded information of a file, paragraph 0020, line 11) to be printed on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer), based on the operational mode set by the operational mode setting unit (paragraph 0013, lines 1-12), and wherein the operational mode setting unit (14, i.e., program database) sets one of the image data of the original (25, i.e., recording medium) acquired by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45, i.e., contactless IC chip) of the original by the radio reader (combination of wireless network and chip id reader terminal (71)) as the data to be printed as the image on the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer), based on the operational mode input to the control panel (paragraph 0012, lines 7-10, and (paragraph 0013, lines 1-12)).

Regarding claim 15, Shinoda discloses a scanner (71, i.e., reader terminal); a printer (60), and a system control unit, wherein the scanner includes: an optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) which optically scans a surface of an original (25, i.e., recording medium), and converts an image on the surface of the original into image data (35, i.e., document); and a radio reader (combination of wireless network and chip id reader terminal (71) ) which reads

data from an IC chip (40, i.e., contactless IC chip) embedded in the original and having a radio communication function (RFID, i.e., Radio Frequency Identifier, paragraph 0024 lines 1-5), the printer includes: an image forming unit (60, i.e., printer) which prints an image on a surface of an image forming medium (20, i.e., recording medium); and a radio writer (combination of wireless network and id managing center (50)) which writes data on an IC chip (45, i.e., contactless IC chip) embedded in the image forming medium (20, i.e., recording medium) and having a radio communication function (RFID, i.e., Radio Frequency Identifier, paragraph 0024 lines 1-5), and the system control unit includes: an operational mode setting unit (14, i.e., program database) which sets the data to be written on the IC chip (45, i.e., contactless IC chip) embedded in the image forming medium (20, i.e., recording medium) by the radio writer (combination of wireless network and id managing center (50)), and the image data (35, i.e., document) to be printed on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer); a first control unit (combination of program database(14), id managing database (12), managing server (10), wireless network, and id managing center (50)) which selects the data to be written on the IC chip embedded in the image forming medium (20, i.e., recording medium) by the radio writer based on an operational mode set by the operational mode setting unit (modes of operation (scanning, printing or chip id issuing or authenticating) are executed by programs stored in program database (14) and the identification is recorded on the chip (40) by id managing center (50), paragraph 0017, lines 1-11 ); and a second control unit (combination of original data managing database (13), program database (14),

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managing server (10), and wireless network) which selects the data to be printed on the surface of the image forming medium by the image forming unit, based on the operational mode set by the operational mode setting unit; and a second control panel to which the operational mode is input by the user, wherein the second control unit (combination of original data managing database (13), program database(14), managing server (10), and wireless network) selects one of the image data on the surface of the original (25, i.e., recording medium) which has been optically scanned by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45, i.e., contactless IC chip) embedded in the original by the radio reader (combination of wireless network and chip id reader terminal (71) ) , as the image data (35 i.e., recorded information of a file, paragraph 0020, line 11) to be printed on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer), based on the operational mode set by the operational mode setting unit (paragraph 0013, lines 1-12), and wherein the operational mode setting unit (14, i.e., program database) sets one of the image data of the original (25, i.e., recording medium) acquired by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45, i.e., contactless IC chip) of the original by the radio reader (combination of wireless network and chip id reader terminal (71)) as the data to be printed as the image on the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer), based on the operational mode input to the control panel (paragraph 0012, lines 7-10, and (paragraph 0013, lines 1-12)), wherein

the first control unit (combination of program database(14), id managing database (12), managing server (10), wireless network, and id managing center (50)) of the system control unit selects one of the image data (35, i.e., document) on the surface of the original (25, i.e., recording medium) which has been optically scanned by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) of the scanner (71, i.e., reader terminal) and the data read from the IC chip (45, i.e., contactless IC chip) embedded in the original (25, i.e., recording medium) by the radio reader (combination of wireless network and chip id reader terminal (71) ) of the scanner, as the data to be written on the IC chip (40) embedded in the image forming medium (20, i.e., recording medium) by the radio writer (combination of wireless network and id managing center (50)) of the printer (60), based on the operational mode set by the operational mode setting unit.

### ***Response to Arguments***

4. Applicant's arguments filed on 04/21/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Shinoda does not disclose or suggest any features in which data to be printed on a surface of an image forming medium (or data to written on an IC chip embedded in the image forming medium) can be selected from either: a) an image on a surface of an original, or b) an image based on the data stored in the IC chip embedded in the original, in accordance with an operational mode instructed by a user, the examiner disagrees. The organization (or user) supervises (via

the server (10)) the authentication, recording and printing of the information requested by the organization. The information is selected from an image on a surface of an original (30); and the image is based on (authentication) data stored in the IC chip (40 or 45) embedded in the original (paragraph 0012, lines 8-15, and 0013, lines 1-12).

In response to applicant's argument that Shinoda does not disclose or suggest any selecting of data to be printed on a surface of an image forming medium in accordance with an operational mode instructed by a user, and that the system of Shinoda does not provide the capability of selecting the image to be printed on a surface of the image forming medium from an image on a surface of an original and an image based on data stored in an IC chip embedded in the original, the examiner disagrees. The selecting of data to be printed on the surface of the image forming medium is based on a printing request initiated by a qualified user (determined through authentication of the document ID).

Although claims 7, 9, 13 and 15 have been amended. The addition of the previous cancelled claims to these amended claims is still not sufficient to overcome the anticipation of Shinoda.

Thus as set forth above, these rejections are proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Wyatt whose telephone number is (571)-272-5974. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on (571)-272-2328. The fax phone number


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for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*K.W.*

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